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| 09/818,547      | 03/28/2001  | Yoshifusa Togawa     | 1075.1152           | 9434             |

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| EXAMINER |
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LIM, KRISNA

|          |              |
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| ART UNIT | PAPER NUMBER |
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2153

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/818,547

Applicant(s)

TOGAWA ET AL.

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-6, 8 and 10-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Claims 1-3, 5-6, 8 and 10-28 are once again presented for examination, and claims 4, 7 and 9 were canceled.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-6, 8 and 10-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly [U.S. Patent No. 6,427,164]. This reference has been used in the previous action.

4. Reilly discloses (e.g., see Fig. 2) the invention substantially as claimed. Taking claim 1 as exemplary claims, the reference discloses a mail system comprising:

- a) a mail source (sending server, abstract (line 5)) from which an e-mail is sent;
- b) one or more destinations (recipient, a receiving server) which receive the e-mail from the mail server at their respective mail address (e.g., see the abstract, cols. 3-4);
- c) a mail address manager (Fig. 2, the abstract, cols. 3-4) managing the respective mail addresses of the destinations, the mail address manager (forwarding server 300) being operative, in response to updating of the mail address (forwarding address, abstract (line 3), cols. 3-4) of at least one destination, to register ("the recipient ... has left a forwarding address", 'forwarding listsrver', abstract, col. 2 (line 66), col. 4 (lines 14-15)) a new

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destination mail address in correlation with such old destination address (e.g., see col. 4, lines 27-43);

d) a mail storing section temporarily storing a particular e-mail (e.g., see col. 3, lines 29-31), which is addressed to said old destination mail address;

a mail sending section (sending e-mail server 140 and forwarding server 300) sending a particular e-mail, which is addressed to said old destination mail address, to said new destination mail address when said new destination mail address is registered in said mail address manager (e.g., see col. 8 (line 15) to col. 9 (line 58)).

5. While Reilly discloses the forwarding listserver for storing temporarily storing a set of data that includes the forwarding information (old email name and new email name) for a period of time, and then this set of data is either manually or automatically renewed or purged, Reilly does not explicitly mention that a particular email was stored until the new email address is registered. It would have been obvious to one of ordinary skill in the art to recognize that in fact the new email address is already registered because Reilly discloses that not only the old address is stored but also the new address (e.g., a set of data that includes the forwarding information).

Reilly does not explicitly mention either the term "mail source" or "mail address manager". However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that Reilly's sending server is obviously the mail source as claimed because the e-mail is received from Reilly's sending server. Moreover, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that Reilly's e-mail servers 140 and 240 are obviously the mail address manager as claimed because Reilly's e-mail servers perform similar operations as claimed mail address manager.

6. As to claim 2, Reilly discloses the mail address manager (e.g., see Fig. 2, the abstract, and cols. 3-4) is a mail server (e-mail server 140), which receives an e-mail from the mail source and sends the e-mail to at least one destination mail address.

7. As to claim 3, Reilly discloses the mail address manager is a plurality of mail server (140, 240 of Fig. 2), which manages the mail address of two or more destinations separately (the abstract, cols. 3-4).

8. As to claim 5, Reilly discloses a notifying section notifying the mail source that the mail address of at least one destination has been updated (e.g., see the abstract, lines 8-9).

9. As to claim 6, Reilly discloses a mail address rewriting section (see the abstract, lines 8-11) rewriting the mail address of at least one destination in an e-mail address book when the mail source is notified by the notifying section that mail address of the at least one destination has been updated (e.g., see the abstract, lines 8-11, cols. 3-4).

10. As to claim 8, Reilly discloses the mail address manager to register the mail address of the destination and attribute information (e.g., see col. 3 (lines 27-35), col. 8 (line 15) to col. 9 (line 58)) respectively unique to the destination in correlation with each other; and when sending an e-mail to the mail address of a particular destination, said mail source inputs said attribute information unique (domain name (e.g., see col. 7, a NDR, col. 9 (lines 11-48) and) to said particular destination for substitution for the mail address of said particular destination so that the last-named e-mail is sent to said particular destination corresponding to said input attribute information.

11. As to claims 9-28, they are similar in scope as of claims 1-3 and 5-8 with the additional features of: an address list (address table) in which a plurality of destination addresses are registered (e.g., see col. 8 (lines 40-67)); a mail address rewriting section (col. 8 (line 15) to col. 9 (line 58)) and the mail address manager (e.g., a mail processing section processing e-mail data) into such a form receivable (new address corresponding to the old address) by the destination based on the last-named destination which information is stored in the storage section (address table or database

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or address book) (e.g., see col. 6 (line 50) to col. 9 (line 58)). Therefore, claims 9-28 are rejected for the same reasons set forth above for claims 1-3 and 5-8.

12. Applicant's arguments filed 10/05/05 have been fully considered but they are not deemed to be persuasive.

In the remarks, applicants argued in substance that:

(a) Reilly is different from the present invention because the present invention teaches that the mail storing section temporarily stores a particular e-mail, which is addressed to an old destination mail address, until a new destination mail address is registered by a mail address manager. In response, Reilly discloses the forwarding listserver for storing temporarily storing a set of data that includes the forwarding information (old email name and new email name) for a period of time, and then this data is either manually or automatically renewed or purged, Reilly does not explicitly mention that a particular email is stored until the new email address is registered. It would have been obvious to one of ordinary skill in the art to recognize that in fact the new email address is already registered because Reilly discloses that not only the old address is stored but also the new address (e.g., a set of data that includes the forwarding information).

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

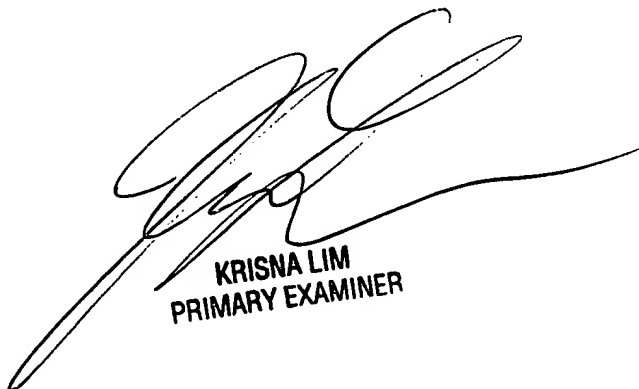
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

October 26, 2005



KRISNA LIM  
PRIMARY EXAMINER